

REMARKS

The Present Invention

The present invention pertains to a method for the therapeutic treatment of cancer due to a genetic defect in the p53 gene, a method for the prophylactic or therapeutic treatment of cancer due to ataxia telangiectasia or Li Fraumeni syndrome and a method for the prophylactic treatment of cancer.

The Pending Claims

Claims 1, 4-21, 28, and 30-49 are currently pending of which claims 1 and 4-21 are directed to a method for the therapeutic treatment of cancer due to a genetic defect in the p53 gene, claim 28 is directed to a method for the prophylactic or therapeutic treatment of cancer due to ataxia telangiectasia or Li Fraumeni syndrome and claims 30-49 are directed to a method for the prophylactic treatment of cancer. Claims 4-21 and 31-48 have been withdrawn from consideration by the Office as being directed to a non-elected species.

The Final Office Action

Claims 31-48 have been withdrawn from consideration by the Office as being directed to a non-elected invention. The Office has maintained the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as allegedly lacking written description. The Office has rejected claims 28-30 and 49 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. An objection has been raised with respect to claim 23. Reconsideration of the objection and rejections is hereby requested.

The Amendments to the Claims

Claims 23 and 29 have been cancelled. Applicants reserve the right to pursue any canceled subject matter in a continuation, continuation-in-part, divisional, or other application. Cancellation of any subject matter should not be construed as abandonment of that subject matter.

Claims 1 and 49 have been amended to delete the terms “abl” and “bcl2.” Claim 28 has been amended to delete “Cowden's disease, Torre's syndrome, Gardner's syndrome, Wiskott-Aldrich syndrome, Peutz-Jeghers syndrome, Bloom's syndrome, Fanconi's syndrome, Wemers syndrome, Chediak-Higashi syndrome, retinoblastoma, Beckwith-Wiedeman syndrome, and neuroblastoma” and to recite or “Li Fraumeni syndrome” as supported by the specification at, for example page 1, line 31 through page

2, line 1. This amendment is being presented in view of the data submitted herewith. The introduction of “Li Fraumeni syndrome” into claim 28 will not require further search and consideration by the Office inasmuch as any relevant one would have been uncovered in searching for cancer, generally. No new matter has been added by way of these amendments.

Discussion of the Written Description Rejection

The Office has maintained the rejection of claim 1 under Section 112, first paragraph, as allegedly lacking written description. This rejection is believed to be moot in view of the amendments to claim 1 to delete terms “abl” and “bcl2.”

Discussion of the Enablement Rejection

The Office has rejected claims 28-30 and 49 under Section 112, first paragraph, as allegedly lacking enablement. This rejection is traversed for the reasons set forth below.

Claim 28 has been amended to delete “Cowden's disease, Torre's syndrome, Gardner's syndrome, Wiskott-Aldrich syndrome, Peutz-Jeghers syndrome, Bloom's syndrome, Fanconi's syndrome, Wemers syndrome, Chediak-Higashi syndrome, retinoblastoma, Beckwith-Wiedeman syndrome, and neuroblastoma,” and to recite “Li Fraumeni syndrome” such that claim 28 is directed to a method for the prophylactic or therapeutic treatment of cancer, wherein the cancer is due to ataxia telangiectasia or Li Fraumeni syndrome. One of ordinary skill in the art is enabled to carry out the method of claim 28 without undue experimentation, as Applicants have demonstrated the prophylactic treatment of *Atm*-deficient mice, which are models of ataxia telangiectasia, accepted by those of ordinary skill in the art as reasonably predictive of utility, with Tempol (see the Declaration under 37 C.F.R. § 1.132 of Dr. James B. Mitchell attached hereto).

Claim 29 has been cancelled in view of the amendment made to claim 28.

Claim 30, which is directed to a method for the prophylactic treatment of cancer, has been rejected as allegedly lacking enablement. However, one of ordinary skill in the art is enabled to practice the present inventive method, as Example 2 and Mitchell et al., *Free Radical Biology & Medicine* 34: 93-102 (2003), which is attached hereto, support that spontaneous tumor incidence in mice decreases upon treatment with Tempol. This data demonstrate that the spontaneous incidence of *any* cancer can be prophylactically treated with Tempol.

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Claim 49 has been amended to delete "abl" and "bcl2," such that claim 49 is now directed to a method for the prophylactic treatment of cancer, wherein the cancer is due to a genetic defect in the p53 gene.

In view of the foregoing, Applicants submit that the pending claims are, in fact, enabled. Therefore, Applicants request that the rejection of claims 28-30 and 49 be withdrawn.

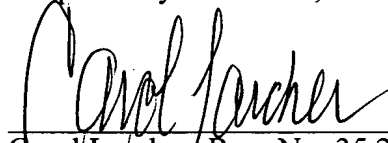
Discussion of the Objection to Claim 23

The Office has objected to claim 23, stating that, if amended to include all of the limitations of the base claim and the intervening claim, claim 23 would be allowable. Claim 23 has been cancelled in view of the amendment made to claim 1. Therefore, this objection is rendered moot.

Conclusion

The application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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